

REMARKS

Claims 64-90 are pending in this application, with claims 65 and 69-89 being withdrawn.

I. Pending Claims Define Patentable Subject Matter

Applicants acknowledge the withdrawal of all prior grounds of rejection in favor of new grounds.

The Office Action rejects claims 64, 68 and 90 under 35 U.S.C. §102(b) over U.S. Patent No. 5,308,427 to Duhaime et al. (Duhaime) in view of U.S. Patent No. 6,092,425 to Kuznia et al. (Kuznia). This rejection is respectfully traversed.

To establish a *prima facie* case of obviousness, the Patent Office must meet three basic criteria: (1) there must be some suggestion or motivation to modify the reference or combine teachings; (2) there must be a reasonable expectation of success; and (3) the reference(s) must teach or suggest all claim features. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed Cir. 1991). See also MPEP §2143. This burden has not been met.

Duhaime teaches at C2/L49-52 that "core 24 is generally made from the same or compatible material as parison 12. The still hot parison 12 warms the surface of core 24 and causes it to partially melt and fuse." Thus, Duhaime teaches to fuse the insert to the wall. Then, after heating, the whole core assembly (insert 24 and wall portion 26) is squashed (Fig. 6) to form a shape that can retain member 28. Thus, not only does Duhaime teach an advantage to a material that melts similar to the wall so it fuses with the plastic tank wall, but teaches that the insert helps to shape the mounting attachment.

Kuznia is not directed to forming of a portion in relief on a wall of a tank. Kuznia is instead directed to non-analogous art of a sensor, which has a plastic housing 12 and a metal insert 26 for mounting a sensing cell within the housing (Figs. 1 and 4). That is, the alleged insert 26 is not taught to create a portion in relief shape for retaining an attachment within an

interior of a tank. Instead, it merely gives access to a sensing cell and provides a structure for mounting the sensing cell.

It would not have been obvious to replace the insert of Duhaime with the metal insert of Kuznia for several reasons. First, obviousness can only be established by modifying references where there is some teaching or suggestion to do so. There is no motivation to look to Kuznia because Kuznia's insert 26 is not taught to assist in shaping of a portion in relief to be used as an attachment element and because Kuznia is not faced with or solves any of the problems faced by Duhaime. The mere fact that references can be modified does not render the combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Second, even if combined, the alleged combination would defeat taught advantages of Duhaime. For example, if the Duhaime insert were replaced with metal as alleged, it would not allow fusing of the insert with the wall, as desired by Duhaime. Additionally, the alleged metal insert would not allow the projection to be squashed by the anvil as desired by Duhaime to form the shape of the projection. A prior art reference "must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." *W.L. Gore & Associates v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert denied*, 469 U.S. (1984). When considered "as a whole," Duhaime teaches away from the alleged combination. This is particularly the case where the alleged insert in Kuznia is for an entirely different purpose.

Moreover, if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). The alleged combination would defeat the intended purpose of Duhaime by preventing fusing of the insert and by preventing the projection from being squashed by the anvil.

Thus, because a *prima facie* case of obviousness has not been established, independent claims 64 and 90 patentable distinguish over the alleged combination. Accordingly, independent claims 64 and 90 are allowable. Rejected dependent claim 68 is allowable for its dependence on allowable base claim 64 and for the additional features recited therein. Withdrawal of the rejection is respectfully requested.

The Office Action rejects claims 66 and 67 under 35 U.S.C. §103(a) over Duhaime in view of Kuznia, further in view of U.S. Patent No. 4,952,347 to Kasugai. This rejection is respectfully traversed.

Duhaime and Kuznia are discussed above. Kasugai fails to overcome the deficiencies of Duhaime with respect to independent claim 64. Accordingly, dependent claims 66 and 67 are allowable for their dependence on allowable base claim 64 and for the additional features recited therein. Withdrawal of the rejection is respectfully requested.

II. Rejoinder of Claims

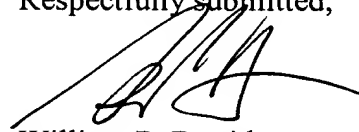
Claims 65, and 69-89 are indicated to be withdrawn. However, because independent claim 64 is generic and allowable for the reasons discussed above, all of dependent claims 65 and 69-89 are also allowable for their dependence on allowable generic claim 64 and must be rejoined and allowed in accordance with MPEP §821.04.

III. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



William P. Berridge
Registration No. 30,024

Stephen P. Catlin
Registration No. 36,101

WPB:SPC/jnm

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OLIFF & BERRIDGE, PLC
P.O. Box 19928
Alexandria, Virginia 22320
Telephone: (703) 836-6400

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